

UNITED STATES DEPARTMENT OF COMMERCE  
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SERIAL NUMBER	REQUEST DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/624,792	3/10/04	ALDO MARRA, ET AL.	126.01

Title: **PORTABLE DOOR LOCK**

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Art Unit	Paper Number
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Correspondence Address:  
DANIEL P. MAGUIRE  
423 E STREET  
DAVIS, CA. 95616

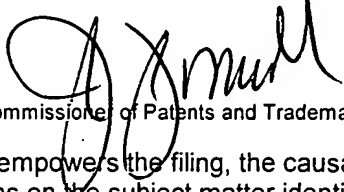
Licensee under 35 U.S.C. 184 is hereby granted to file in any foreign country a patent application and any amendments thereto corresponding to the subject matter of this U.S. application identified above and/or any material accompanying the petition. This license is conditioned upon modification of any applicable secrecy order and is subject to revocation without notice.

License Number: 535,260

Grant Date: 23-Sep-05

**This license is granted retroactively to the date(s) and the country(s) indicated on the attached decision.**

Approved:

  
for Commissioner of Patents and Trademarks

This license empowers the filing, the causation and the authorization of the filing of a foreign application or applications on the subject matter identified above, subsequent forwarding of all duplicate and formal papers and the prosecution of such application or applications.

This license does not empower the filing of any applications, amendments, supplements or continuances originating in this country which disclose inventions, modifications, or variations not disclosed in the subject matter identified above.

This license is to be retained by the licensee and may be used at anytime on or after the date thereof. This license is not retroactive unless specifically indicated.

The grant of this license does not in any way lessen the responsibility of the licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations, especially with respect to certain countries, of other agencies, particularly the Office of Foreign Assets Control, Department of the Treasury; Office of Munitions Control, Department of State (with respect to Arms, Munitions and Implements of War); the Bureau of Trade Regulation, Office of Export Administration, Department of Commerce; and the Department of Energy.

**LICENSE FOR FOREIGN FILING**

[Title 35, United States Code (1952) Sections 184, 185, 186]



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, DC 20231  
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David P. Maguire  
423 E Street  
Davis, CA. 95616

In re: Marra et al : DECISION ON REQUEST  
Serial No.: 10/624,792 : UNDER 37 CFR 5.25  
Filing date: July 22, 2003  
Docket No: 126.01

Title: **PORTABLE DOOR LOCK**

This is a decision on the petition filed on April 30, 2004 for retroactive foreign filing license.

It has been determined that a retroactive license for foreign filing under 35 U.S.C.184 be granted with respect to the filings listed below. The petition complies with 37 C.F.R. 5.25 in that there is an adequate showing that the subject matter in question was not under a secrecy order, that the license was diligently sought after discovery of the proscribed foreign filing, and that the material was filed abroad without the required license under 37 C.F.R 5.11 through error and without deceptive intent.

**Country**

**Date**

PCT

December 29, 2003

Ian J. Lobo  
Patent Examiner  
(571) 272-6974

JFW

DHE



## UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Aldo Marra, et al.

Date: April 27, 2004

Application No.: 10/624,792

Group Art Unit: Unknown

Filed: July 22, 2003

Examiner: Unknown

For: Portable Door Lock

Attorney Ref. No.: 126.01

*Response to Decision on Request Under 37 CFR 5.25*

Mail Stop Petition  
 Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450

Dear Sir or Madam:

The applicants, Aldo and Yael Marra, hereby respond to the Decision on Request Under 37 CFR 5.25 ("Decision") that was mailed on March 25, 2004. The Decision denied the applicants' petition for a retroactive filing receipt, for two reasons: (i) the alleged failure to provide a listing of the countries in which the foreign application was filed, along with the dates of filing, and (ii) lack of sufficient evidence that the foreign application was filed through error and without deceptive intent. The applicant responds to these points below, and with the new information provided by the applicants, the petition should now be granted.

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*Date and Country of Filing*

The applicants respectfully disagree with the claim that they failed to identify the countries and dates of foreign filing. On page 1 of the declaration of Aldo Marra, the applicants stated that: "British counsel filed a PCT patent application with the World Intellectual Property Organization (WIPO) on or about December 29, 2003." This

statement identifies both the jurisdiction of the filing -- "the World Intellectual Property Organization" -- and the date -- "on or about December 29, 2003."

Perhaps the examiner wants the information in list format:

<u>Type of Filing</u>	<u>Country of Filing</u>	<u>Date</u>	<u>Application Number</u>
PCT Chapter I Request	International Bureau World Intellectual Property Organization (Geneva, Switzerland)	29 Dec. 2003	PCT/IB03/06220

Or perhaps the examiner wants a listing of the countries that were designated in the PCT Chapter I filing:

**Countries/Jurisdictions Designated in PCT Chapter I Filing (see page 3 of Request, attached to Miller Decl.)**

- |                         |                                  |                    |
|-------------------------|----------------------------------|--------------------|
| 1. Aripo                | Herzegovina                      | 25. Germany        |
| 2. Eurasian Patent      | 13. Barbados                     | 26. Denmark        |
| 3. European             | 14. Bulgaria                     | 27. Dominica       |
| 4. OAPI                 | 15. Brazil                       | 28. Algeria        |
| 5. United Arab Emirates | 16. Belarus                      | 29. Ecuador        |
| 6. Antigua and Barbuda  | 17. Belize                       | 30. Estonia        |
| 7. Albania              | 18. Canada                       | 31. Spain          |
| 8. Armenia              | 19. Switzerland and Lichtenstein | 32. Finland        |
| 9. Austria              | 20. China                        | 33. United Kingdom |
| 10. Australia           | 21. Colombia                     | 34. Grenada        |
| 11. Azerbaijan          | 22. Costa Rica                   | 35. Georgia        |
| 12. Bosnia and          | 23. Cuba                         | 36. Ghana          |
|                         | 24. Czech Republic               | 37. Gambia         |
|                         |                                  | 38. Croatia        |

- |                         |                        |                           |
|-------------------------|------------------------|---------------------------|
| 39. Hungary             | Macedonia              | 83. Turkmenistan          |
| 40. Indonesia           | 61. Mongolia           | 84. Tunisia               |
| 41. Israel              | 62. Malawi             | 85. Turkey                |
| 42. India               | 63. Mexico             | 86. Trinidad and Tobago   |
| 43. Iceland             | 64. Mozambique         | 87. United Republic of    |
| 44. Japan               | 65. Nicaragua          | Tanzania                  |
| 45. Kenya               | 66. Norway             | 88. Ukraine               |
| 46. Kyrgyzstan          | 67. New Zealand        | 89. Uganda                |
| 47. Democratic People's | 68. Oman               | 90. United States of      |
| Republic of Korea       | 69. Papua New Guinea   | America                   |
| 48. Republic of Korea   | 70. Phillipines        | 91. Uzbekistan            |
| 49. Kazakhstan          | 71. Poland             | 92. Saint Vincent and the |
| 50. Saint Lucia         | 72. Portugal           | Grenadines                |
| 51. Sri Lanka           | 73. Romania            | 93. Viet Nam              |
| 52. Liberia             | 74. Russian Federation | 94. Serbia and            |
| 53. Lesotho             | 75. Seychelles         | Montenegro                |
| 54. Lithuania           | 76. Sudan              | 95. South Africa          |
| 55. Luxembourg          | 77. Sweden             | 96. Zambia                |
| 56. Latvia              | 78. Singapore          | 97. Zimbabwe              |
| 57. Morocco             | 79. Slovakia           | 98. Botswana              |
| 58. Republic of Moldova | 80. Sierra Leone       | 99. Egypt                 |
| 59. Madagascar          | 81. Syrian Arab        |                           |
| 60. The Former          | Republic               |                           |
| Yuogslav Republic of    | 82. Tajikistan         |                           |

Or perhaps the examiner objects to the applicant's statement that the PCT filing was made "on or about" December 29, 2003. The applicant hereby states that the PCT filing was made *on* December 29, 2003. (See Decl. of John Miller).

The applicant has now clearly complied with the requirements of 37 CFR 5.25 (1) and (2).

***The PCT Filing Was Made Through Error and Without Deceptive Intent***

As explained in the applicants' original petition, the PCT filing in this case was made because the applicants, who are laypersons and were not familiar with the requirements for a foreign filing license, engaged British counsel to file a foreign application. As explained below, British counsel was unaware that a foreign filing license had not been obtained, and therefore made the foreign filing as a result of an honest error.

The applicants now submit a declaration from their British counsel, John Miller. Mr. Miller is a patent attorney employed by the firm Brookes Batchellor LLP in Tunbridge Wells, U.K. Mr. Miller met with applicant Aldo Marra on December 8, 2003, and thereafter he filed the foreign application identified above on December 29, 2003.

At the time he made the filing, Mr. Miller was unaware that Mr. Marra had not yet received a foreign filing license from the USPTO. Mr. Miller knew that the US application had been filed nearly five months before, and he assumed that the foreign filing license had been issued by the USPTO. In fact, the issuance of the filing receipt and foreign filing license were delayed because a batch of applications (including the present application) were apparently overlooked by the OIPE. The applicant has now

received a foreign filing license, effective as of March 10, 2004.

Therefore, the foreign filing was made through error and without deceptive intent, since foreign counsel mistakenly but reasonably assumed that a foreign filing of the subject application would be allowed given the time that had elapsed since the US filing. For further details regarding the foreign filing, please see the Declaration of John Miller, the contents of which are incorporated by reference herein.

Therefore, the applicants respectfully petition for a foreign filing license with an effective date of December 1, 2003.

Dated: 4/27/2004

Daniel P. Maguire  
Daniel P. Maguire

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/624,792	10-Mar-04	ALDO MARRA, ET AL.	126.01

Title: PORTABLE DOOR LOCK

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Art Unit	Paper Number
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Correspondence Address:  
DANIEL P. MAGUIRE  
423 E STREET  
DAVIS, CA. 95616

PATENT & TRADEMARK OFFICE  
**MAILED**

MAR 25 2004

LICENSING & REVIEW

Please find attached a communication from the Examiner regarding the  
Petition for Retroactive License under 37 CFR 5.25.





UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, DC 20231  
www.uspto.gov

Daniel Maguire  
423 E Street  
Davis, CA 95616

In re: Marra et al : DECISION ON REQUEST  
Serial No.: 10/624,792 : UNDER 37 CFR 5.25  
Filing date: July 22, 2003  
Docket No: 126.01

Title: **PORTABLE DOOR LOCK**

This is a decision on the petition filed on March 10, 2004 for retroactive foreign filing license.

37 CFR 5.25(a) requires the following:

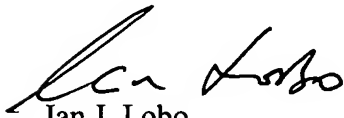
1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
  - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
  - ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
  - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee (§ 1.17(h)).

The petition is denied since none of the requirements of 37 CFR 5.25 (1) (2) and (3)(ii-iii) have been met.

First, a listing, of each of the foreign countries in which the unlicensed patent application was filed and the dates on which the material was filed in each country is required.

The petition is also denied under 37 CFR 5.25 (3)(ii-iii). In order to secure a retroactive foreign filing license, applicant or petitioners must provide evidence that the subject matter was filed abroad through error and without deceptive intent. The instant petition fails in that it lacks sufficient evidence to conclude that the material was filed abroad through error and without deceptive intent. Sufficient evidence would include a verified statement or statements by the person or persons (in the instant case the British counsel) who had knowledge and made the actual decision to file. Such a statement should reference the error of not obtaining a foreign license. Statements of error must be supported by fact. They should not be merely conclusionary but must include how and why the error occurred.

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is denied, and in the absence of any response within **60 days** of the mailing date of this letter, such denial will be made final and the final action under 35 U.S.C. 185 will be taken. Extensions of time may be had under 37 C.F.R. 1.136(a).

A handwritten signature in black ink, appearing to read 'Ian J. Lobo', written in a cursive style.

Ian J. Lobo  
Patent Examiner  
(703) 306-4161



UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Aldo Marra, et al.

Application No.: 10/624,792

Filed: July 22, 2003

For: Portable Door Lock

Date: February 12, 2004

Group Art Unit: Unknown

Examiner: Unknown

Attorney Ref. No.: 126.01

*Petition for Retroactive Foreign Filing License*

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir or Madam:

The applicants, Aldo and Yael Marra, hereby petition the USPTO for a retroactive foreign filing license under 37 CFR §5.25. The present application was filed on July 22, 2003, but no filing receipt or foreign filing license has yet been received. Status inquiries to the OIPE have revealed that this application is still undergoing initial processing.

Unbeknownst to the undersigned counsel, the applicants retained British counsel, and British counsel filed a PCT patent application with the World Intellectual Property Organization (WIPO) on or about December 29, 2003. As explained in the attached declaration, no subject matter in the present application was under a secrecy order at the time of the foreign filing, and this foreign filing was made through error and without deceptive intent. Therefore, a retroactive foreign filing license under 37 CFR §5.25 should be granted.

Therefore, the applicants respectfully petition for a foreign filing license with an effective date of December 1, 2003.

Dated: February 12, 2004

Daniel P. Maguire  
Daniel P. Maguire

*Petition for Retroactive Foreign Filing License*

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